REMARKS

This is a full and timely response to the outstanding final Office Action mailed June 16, 2006 (Paper No. 20060612). Upon entry of this response, claims 3-5, 7-11, 16, 18, 62-64, 66-77, 79, and 82-112 are pending in the application. In this response, claims 63, 79, 82-86, and 105 have been amended, claim 112 has been added, and claims 1-2, 6, 12-15, 17, 19-61, 65, 78, and 80-81 have been cancelled. Applicants respectfully request that the amendments being filed herewith be entered and request that there be reconsideration of all pending claims.

1. Rejection of Claims 105-111 under 35 U.S.C. §103

Claims 105-111 have been rejected under §103(a) as allegedly obvious over *Dinh et al.* (6,434,615) in view of Applicants' admitted prior art (AAPA). Applicants respectfully submit that this rejection has been overcome by claim amendments made herein. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

A. Claim 105

1) The proposed combination does not disclose, teach, or suggest "identifying a statically configured second communication channel to the second communication device that is associated with the predefined identifier"

Claim 105 has been amended to recite "identifying a statically configured second communication channel". *Dinh et al.* does not disclose, teach, or suggest this feature. *Dinh et al.* that "an Internet/Intranet communication line is established between the controlling computer system 210 and the first remote standalone computer system 270." (Col. 6, lines 5-15.) Applicants will assume, *arguendo*, that this "communication line" between the controller 120 and the remote 270 corresponds to a communication

channel to the remote device. Even so, there is no teaching or suggestion in *Dinh et al.* that this communication line is "statically configured" as recited in amended claim 105.

AAPA also fails to teach, suggest, or disclose a computer implementation of the above-described feature recited in amended claim 105. Since these two references, either alone or in combination, do not teach at least the above-described features recited in claim 105, a *prima facie* case establishing an obviousness rejection has not been made. Thus, claim 105 is not obvious under the proposed combination of *Dinh et al.* in view of AAPA, and the rejection should be withdrawn.

2) The proposed combination does not disclose, teach, or suggest "coupling the first communication channel to the second communication channel to establish connectivity between the first communication device and the second communication device"

The Office Action alleges that *Dinh et al.* discloses this feature in Col. 6, lines 4-16. (Office Action, p. 3). Applicants respectfully disagree. *Dinh et al.* merely discloses the broad concept of establishing a communication link between devices: "[when] the first diagnostic server applications 240 decodes the diagnostic command for the first remote standalone computer 270, an Internet/Intranet communication line is established between the controlling computer system 120 and the first remote standalone computer system 270". (Col. 6, lines 8-13.) *Dinh et al.* treats the network or networks connecting the diagnostic server 240 and the standalone computer 270 as a black box. *Dinh et al.* does not disclose how the link between the two devices is established, and does not disclose the specific feature recited in claim 105 of "coupling the first communication channel to the second communication channel to establish connectivity between the first communication device and the second communication device."

3) The Office Action failed to provide proper motivation or suggestions for combining the references

Applicants respectfully submit one of ordinary skill in the art would not be motivated to combine the two references, because *Dinh et al.* has no reason to treat the network as anything more than a black box. *Dinh et al.* merely discloses the broad concept of establishing a communication link between devices: "[when] the first diagnostic server applications 240 decodes the diagnostic command for the first remote

standalone computer 270, an Internet/Intranet communication line is established between the controlling computer system 120 and the first remote standalone computer system 270". (Col. 6, lines 8-13.) *Dinh et al.* is not directed to the problem of establishing a channel between the two systems, instead assuming that the Internet provides such a channel. Thus, one of ordinary skill in the art would have no reason to look to AAPA, which describes a system in which devices in two different networks are unable to communicate with each other since the networks are operated by different providers.

Applicants respectfully assert that Examiner has embarked on what appears to be improper hindsight reasoning to support the 35 U.S.C. §103(a) rejection. The network location of the two devices is relevant to Applicants' invention, and is recited in claim 105, but is not relevant to *Dinh et al.* "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using applicants' structure as a template and selecting elements from references to fill the gaps." *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

B. Claims 106-111

Since claim 105 is allowable, Applicants respectfully submit that claims 106-111 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 106-111 be withdrawn.

2. Rejection of Claims 3-5, 7-11, 16, 62-64, 66-69, 74-84, 86-92, 95-99, and 101-104 under 35 U.S.C. §103

Claims 3-5, 7-11, 16, 62-64, 66-69, 74-84, 86-92, 95-99, and 101-104 have been rejected under §103(a) as allegedly obvious over *Dinh et al.* (6,434,615) in view of Applicants' admitted prior art (AAPA and *Son* (6,697,376). Applicants respectfully submit that the rejection of claims 63-64, 66-69, 74-77, 79-84, and 86 has been overcome by claim amendments made herein. Applicants respectfully submit that the rejection of claim 78 has been rendered moot by claim cancellation. Applicants respectfully traverse the rejection of claims 87-92, 95-99, and 101-104. It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being

obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

A. Claim 63

1) The proposed combination does not disclose, teach, or suggest "configuring a network device to establish a route between the first communication device and the second communication device using the identified second communication channel"

The Office Action alleges that *Dinh et al.* discloses this feature in Col. 6, lines 4-16. (Office Action, p. 3). Applicants respectfully disagree. *Dinh et al.* merely discloses the broad concept of establishing a communication link between devices: "[when] the first diagnostic server applications 240 decodes the diagnostic command for the first remote standalone computer 270, an Internet/Intranet communication line is established between the controlling computer system 120 and the first remote standalone computer system 270". (Col. 6, lines 8-13.) *Dinh et al.* treats the network or networks connecting the diagnostic server 240 and the standalone computer 270 as a black box. *Dinh et al.* does not disclose how the link between the two devices is established, and does not disclose the specific feature recited in claim 63 of "configuring a network device to establish a route between the first communication device and the second communication device using the identified second communication channel".

The Office Action further alleges that *Son* discloses this feature in Col. 10, lines 16-29. The cited portion of *Son* contains no discussion whatsoever of configuring a network device. Furthermore, Applicants can find no discussion in any other portion of *Son* that discloses the claimed feature. AAPA also fails to teach, suggest, or disclose a computer implementation of the above-described feature recited in claim 63. Since these two references, either alone or in combination, do not teach at least the above-described features recited in claim 63, a *prima facie* case establishing an obviousness rejection has not been made. Thus, claim 63 is not obvious under the proposed combination of *Dinh et al.* in view of AAPA and further in view of *Son*, and the rejection should be withdrawn.

2) The Office Action failed to provide proper motivation or suggestions for combining the references

Applicants respectfully submit one of ordinary skill in the art would not be motivated to combine any two of the three references. First, there is no motivation to combine *Dinh et al.* with AAPA because the primary reference, *Dinh et al.*, has no reason to treat the network as anything more than a black box. With respect to establishing a communication link between devices, *Dinh et al.* merely discloses the broad concept: "[when] the first diagnostic server applications 240 decodes the diagnostic command for the first remote standalone computer 270, an Internet/Intranet communication line is established between the controlling computer system 120 and the first remote standalone computer system 270". (Col. 6, lines 8-13.) *Dinh et al.* is not directed to the problem of establishing a channel between the two systems, instead assuming that the Internet provides such a channel. Thus, one of ordinary skill in the art would have no reason to look to AAPA, which describes a system in which devices in two different networks are unable to communicate with each other since the networks are operated by different providers.

Second, there is no motivation to combine *Dinh et al.* with the "predefined channel and PID" disclosed at Col. 10, lines 16-29 of *Son*. *Son* describes to video-on-demand between a headend cable system and a set-top box. *Dinh et al.* describes executing diagnostics on a remote computer system using a controlling computer system. Although both references include some discussion of communication channels, so do many thousands of applications. A person of ordinary skill in the art would have no reason to combine these particular two references, since they are directed to different types of systems and solve completely different problems.

B. Claim 87

1) The proposed combination does not disclose, teach, or suggest "identifying a predefined second communication channel to the second communication device that is associated with the predefined identifier "

The Office Action alleges that *Dinh et al.* discloses this feature in Col. 6, lines 4-16. (Office Action, p. 4).The Office Action further explains the rationale for the rejection in the "Response to Arguments" section:

> As taught by *Dinh et al.*, a communication channel is established when the first diagnostic server application decodes the diagnostic command for the first remote standalone computer (Dinh: Col. 6, lines 8-13.) After a communication channel is defined, data packets may be transmitted between computing devices. Accordingly, a "predefined" communication channel is identified and utilized when packets are transmitted/received.
> (Office Action, pl 10, lines 10-15.)

Applicants submit that the Examiner is using an impermissibly broad reading of the claimed feature "predefined second communication channel", one which reads the limitation out of the claim. The Examiner appears to argue that a channel is "predefined" simply because it the channel is, at some point, defined.

Applicants agree that at some point before use, *Dinh et al.* defines a channel. However, the single sentence in *Dinh et al.* which describes establishing the channel appears to disclose a channel that is dynamically defined after receiving information about the standalone computer 270: "[when] the first diagnostic server applications 240 decodes the diagnostic command for the first remote standalone computer 270, an Internet/Intranet communication line is established between the controlling computer system 120 and the first remote standalone computer system 270." (Col. 6, lines 8-13.) Applicants submit that this dynamic channel in *Dinh et al.* cannot correspond to the plain meaning of the "predefined second communication channel" recited in claim 87.

> 2) The proposed combination does not disclose, teach, or suggest "instructing a network device to couple the first communication channel to the second communication channel"

The Office Action alleges that *Dinh et al.* discloses this feature in Col. 6, lines 4-16. (Office Action, p. 3). Applicants respectfully disagree. *Dinh et al.* merely discloses the broad concept of establishing a communication link between devices: "[when] the first diagnostic server applications 240 decodes the diagnostic command for the first remote standalone computer 270, an Internet/Intranet communication line is established between the controlling computer system 120 and the first remote standalone computer system 270". (Col. 6, lines 8-13.) *Dinh et al.* treats the network or networks connecting the diagnostic server 240 and the standalone computer 270 as a black box. *Dinh et al.* does not disclose how the link between the two devices is established, and does not

disclose the specific feature recited in claim 87 of "instructing a network device to couple the first communication channel to the second communication channel l".

The Office Action further alleges that *Son* discloses this feature in Col. 10, lines 16-29. The cited portion of *Son* contains no discussion whatsoever of instructing a network device. Furthermore, Applicants can find no discussion in any other portion of *Son* that discloses the claimed feature. AAPA also fails to teach, suggest, or disclose a computer implementation of the above-described feature recited in claim 87. Since these two references, either alone or in combination, do not teach at least the above-described features recited in claim 87, a *prima facie* case establishing an obviousness rejection has not been made. Thus, claim 87 is not obvious under the proposed combination of *Dinh et al.* in view of AAPA and further in view of *Son*, and the rejection should be withdrawn.

3) The Office Action failed to provide proper motivation or suggestions for combining the references

Applicants respectfully submit one of ordinary skill in the art would not be motivated to combine any two of the three references. First, there is no motivation to combine *Dinh et al.* with AAPA because the primary reference, *Dinh et al.*, has no reason to treat the network as anything more than a black box. With respect to establishing a communication link between devices, *Dinh et al.* merely discloses the broad concept: "[when] the first diagnostic server applications 240 decodes the diagnostic command for the first remote standalone computer 270, an Internet/Intranet communication line is established between the controlling computer system 120 and the first remote standalone computer system 270". (Col. 6, lines 8-13.) *Dinh et al.* is not directed to the problem of establishing a channel between the two systems, instead assuming that the Internet provides such a channel. Thus, one of ordinary skill in the art would have no reason to look to AAPA, which describes a system in which devices in two different networks are unable to communicate with each other since the networks are operated by different providers.

Second, there is no motivation to combine *Dinh et al.* with the "predefined channel and PID" disclosed at Col. 10, lines 16-29 of *Son*. *Son* describes to video-on-

demand between a headend cable system and a set-top box. *Dinh et al.* describes executing diagnostics on a remote computer system using a controlling computer system. Although both references include some discussion of communication channels, so do many thousands of applications. A person of ordinary skill in the art would have no reason to combine these particular two references, since they are directed to different types of systems and solve completely different problems.

C. Claims 3-5, 7-11, 16, 62, 64, 66-69, 74-77, 92, 95-99, and 101-104

Since claims 63 and 87 are allowable, Applicant respectfully submits that claims 3-5, 7-11, 16, 62, 64, 66-69, 74-77, 92, 95-99, and 101-104 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 3-5, 7-11, 16, 62, 64, 66-69, 74-77, 92, 95-99, and 101-104 be withdrawn.

D. Claim 78

Claim 78 is cancelled without prejudice, waiver, or disclaimer, and the rejection of this claim is therefore rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of this cancelled claim in a continuing application, if Applicants so choose, and do not intend to dedicate any of the cancelled subject matter to the public. Applicants expressly reserve the right to present cancelled claim 78, or variants thereof, in continuing applications to be filed subsequent to the present application.

E. Claims 79-86

Claims 79-86 have been amended to depend from newly added claim 112. Since claim 112 is allowable for at least the reasons discussed below, Applicant respectfully submits that claims 79-96 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir.

1988). Therefore, Applicants respectfully request that the rejection of claims 79-86 be withdrawn.

3. Rejection of Claims 70-71 and 85 under 35 U.S.C. §103

Claims 70-71 and 85 have been rejected under §103(a) as allegedly obvious over *Dinh et al.* (6,434,615) in view of *Son* (6,697,376) and *Montenegro* (1,232,356). Applicants respectfully submit that the rejection of claim 85 has been rendered moot by claim cancellation, and traverse the rejection of claims 70-71. Since claim 63 is allowable, Applicants respectfully submit that claims 70-71 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 70-71 and 85 be withdrawn.

4. Rejection of Claims 18, 73, and 94 under 35 U.S.C. §103

Claims 18, 73, and 94 have been rejected under §103(a) as allegedly obvious over *Dinh et al.* (6,434,615) in view of *Son* (6,697,376) and *Dowling* (6,574,239). Applicants respectfully traverse this rejection. Since claims 63 and 87 are allowable, Applicants respectfully submit that claims 18, 73, and 94 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 18, 73, and 94 be withdrawn.

5. Rejection of Claims 93 and 100 under 35 U.S.C. §103

Claims 93 and 100 have been rejected under §103(a) as allegedly obvious over *Dinh et al.* (6,434,615) in view of *Son* (6,697,376) and *Montenegro* (1,232,356). Applicants respectfully traverse this rejection. Since claim 87 is allowable, Applicants respectfully submit that claims 93 and 100 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 93 and 100 be withdrawn.

6. Newly Added Claims

Applicants submit that new claim 112 is allowable over the cited references. Specifically, independent claim 112 is allowable for at least the reason that the cited references do not teach, disclose, or suggest the features of "creating, upon user request, a statically configured predefined first channel between the managed communication device and an access unit within an access provider network...instructing a network device to couple the statically configured predefined channel to the second channel, producing a third channel." Therefore, Applicants request the Examiner to enter and allow the above new claims.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 3-5, 7-11, 16, 18, 62-64, 66-77, 79, and 82-112 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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